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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,983	02/21/2006	Gordon L. Monsen	114594-02WOUS	3432
38492 7590 06/25/2008 WILLKIE FARR & GALLAGHER LLP INTELLECTUAL PROPERTY LEGAL ASSISTANTS 787 SEVENTH AVE NEW YORK, NY 10019-6099			EXAMINER AMEL UNKEN, BARBARA J	
			ART UNIT 3694	PAPER NUMBER
			MAIL DATE 06/25/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/549,983

**Applicant(s)**

MONSEN ET AL.

**Examiner**

Barbara J. Amelunxen

**Art Unit**

4137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-148 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-148 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s) Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s) Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Election of Species**

1. This application contains claims directed to the following patentably distinct Species:

- Species A: Represented by the first preferred embodiment where Tripartite Mezzanine structure 100 may use two tripartite agreements 140, 150 that are linked by two Depository Accounts 144, 154 controlled by independent servicers 142, 152 (Fig 1 and Fig 2; ¶ 0027).
- Species B: Represented by the second preferred embodiment where the contractual obligations of Cash Management Special Purpose Entity (CM-SPE) 136 and servicers 142, 152 to Senior Lender 110, to Tripartite Mezzanine Lender 102 and to Borrower 130 are clear, a single entity may perform two, or all three roles (Fig 1 and Fig 2; ¶ 0034).
- Species C: Represented by the third preferred embodiment where the Senior Lender 110 may approve a subordinate assignment 138 of the lease and of the lease rent cash flows 108 to CM-SPE 136 or to Tripartite Mezzanine Lender 102 (Fig 1 and Fig 2; ¶ 0036).

- Species D: Represented by the fourth preferred embodiment where Tripartite Mezzanine Lender 102 may look to Borrower 130 or Principal Owner 132, to repay the remaining principal balance in the event of a default by Tenant 104 (Fig 1 and Fig 2; ¶ 0037).

- Species E: Represented by the fifth preferred embodiment where Tripartite Mezzanine Lender 102 may take "soft second" mortgage, a mortgage collateralized by a pledge of equity interests of Borrower 130 or Principal Owner 132, but without any lien directly against the real estate (Fig 1 and Fig 2; ¶ 0038).

- Species F: Represented by the sixth preferred embodiment where Tripartite Mezzanine Loan 100 may be structured as a fully self amortizing level-payment loan (Fig 1 and Fig 2; ¶ 0042).

- Species G: Represented by the seventh preferred embodiment where Tripartite Mezzanine Loan 100 may be structured as an interest only loan for an initial portion of the term, and the remaining term of the loan may use self amortizing payments (Fig 1 and Fig 2; ¶ 0043).

- Species H: Represented by the eight preferred embodiment where the Tripartite Mezzanine Loans may be sold on a whole loan basis fairly readily, because the expected loss rate on a Tripartite Mezzanine Loan 100 may be lower than that of a corporate bond ((Fig 1 and Fig 2; ¶ 0046; and § VI.D.).

- Species I: Represented by the ninth preferred embodiment where the Tripartite Mezzanine Lender 102 the right to assign, syndicate, sell, pledge, securitize, or participate all or any portion of a Tripartite Mezzanine Loan to Investors

190. Borrower 130 may agree to cooperate in any such arrangement (Fig 1 and Fig 2; ¶ 0047).

- Species J: Represented by the tenth preferred embodiment where Tripartite Mezzanine Loan 100 is made with no collateral from the property or ownership interest (Fig 1 and Fig 2; ¶ 0055).

- Species K: Represented by the eleventh preferred embodiment where Tripartite Mezzanine Loan 100 is isolated from the property, and collateralized solely by the creditworthiness of Tenant 104, credit derivatives may be used to hedge out much or all of the default risk (Fig 1 and Fig 2; ¶ 0055).

- Species M: Represented by the twelve preferred embodiment where The principal may be hedged by buying put options on debt or equity securities of Tenant 104, one put corresponding to each year remaining in the tenor of the Loan 100 (Fig 1 and Fig 2; ¶ 0058).

- Species N: Represented by the thirteenth preferred embodiment where the Tripartite Mezzanine Loans 100 may be wrapped in Over-collateralized Account 260, set aside out of the excess spread above the blended senior unsecured borrowing rate of Tenant 104, or by a premium at issue, to provide a significant recovery for Tripartite Mezzanine Lender 102 or Investors 190 in the event of a default. (Fig. 2d; ¶ 0063).

- Species O: Represented by the fourteenth preferred embodiment where Tripartite Mezzanine Lender 102 may be given absolute discretion to approve any transfer that would result in (a) a change in control of Borrower 130, (b) Borrower

130 or any single purpose entity holding equity in Borrower 130 ceasing to be a single purpose entity, or (c) a dissolution or termination of Borrower 130. (¶ 0080).

- Species P: Represented by the fifteenth preferred embodiment where Tripartite Mezzanine Loan Structure may be structured so that the Senior Lender 110 and Tripartite mezzanine Lender 102 take control 312, 314 of the lease payments, and leave the property itself and the partnership interests 316 unencumbered, available, as collateral for third and fourth mortgages) (Fig. 3; ¶ 0087).

- Species Q: Represented by the sixteenth preferred embodiment where Borrower 130 may obtain financing whose payment exceed the total amount supported by the lease cash flows (Fig. 4; ¶ 0088).

- Species R: Represented by the seventeenth preferred embodiment where the Tripartite Mezzanine Loan structure includes a subordinate assignment 138 of the lease rent and cash flows, the collateral is technically subordinate to the interest of Senior Lender 110 (Fig. 5; ¶ 0099).

2. The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

3. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

4. There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**5. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.**

6. The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species

requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

7. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

8. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

9. A telephone call was not made.

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim



remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BARBARA JOAN AMELUNXEN whose telephone number is (571) 270-5297. The examiner can normally be reached on Monday - Friday 8am-5pm.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on 571.272.6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Barbara Joan Amelunxen/  
Examiner, Art Unit 4137

June 19, 2008

/Calvin L Hewitt II/  
Supervisory Patent Examiner, Art Unit 4137

1. A telephone call was not made.

***Conclusion***

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BARBARA JOAN AMELUNXEN whose telephone number is (571) 270-5297. The examiner can normally be reached on Monday-Friday 7:30 am-5:00 pm.

3. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

4. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Barbara Joan Amelunxen/  
Examiner, Art Unit 4137

June 11, 2008

/Calvin L Hewitt II/

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